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JUL 16 2008

OFFICE OF PETITIONS

In re Application of	:	
Gary Karlin Michelson	:	
Application No. 10/047,545	:	ON PETITION
Filed: January 16, 2002	:	
Attorney Docket No. 101.0053-01000	:	

This is a decision on the petition under 37 CFR 1.313(a), filed July 10, 2008, to withdraw the above-identified application from issue.

The petition is **DISMISSED**.

Petitioner requests that the present application be withdrawn from issue for continued prosecution based on a rejection raised in parent application serial no. 08/480,908, filed June 07, 1995. Petitioner indicates that in parent 08/480,908 a provisional obviousness-type double patenting rejection was made that would be properly applicable to both the present application and the parent application 08/480,908.

37 CFR 1.313(a) states, in part:

Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary.

As such, a grantable petition requesting withdrawal of an application from issue must be accompanied by: (1) a showing of good and sufficient reasons why withdrawal of the application from issue is necessary; and (2) the requisite petition fee under 37 CFR 1.17(h). The petition fee of \$130.00 has been charged to petitioner's deposit account.

Requirement (1) is at issue. The petition does not set forth good and sufficient reasons as to why withdrawal of the application from issue is necessary. A review of the file of parent application Serial No. 08/480,908 does not indicate the presence of the ODP rejection in the current Office

action dated June 27, 2008, as alleged by petitioner. Hence the allegation of a potential and possible rejection here, based on the facts given, does not make withdrawal of the application from issue necessary. But in any event there are other avenues open to applicant to have this issue considered and resolved other than by way of petition.

Following the part of 37 CFR 1.313(a) cited above, 37 CFR 1.313(a) goes on to state:

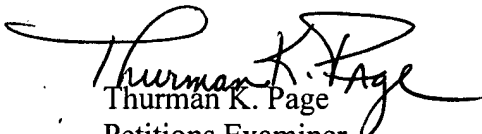
A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee.

The filing of a request for continued examination (RCE) under 37 CFR 1.114 with a submission and the fee set forth in 37 CFR 1.17(e) would have been a proper available option to have the issue considered. It is well documented that the citation of documents on an IDS that complies with 37 CFR 1.97 and 1.98 satisfies the submission requirement under 37 CFR 1.114. *See* MPEP 706.07(h)(II).

For the above reasons, this application will not be withdrawn from issue under the provisions of 37 CFR 1.313(a).

Any inquiries regarding this decision should be directed to the undersigned at (571) 272-0602.

This application is being returned to the Office of Publication.


Thurman K. Page
Petitions Examiner
Office of Petitions

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TO:

FROM:

Name: Office of Petitions

Name: Thomas H. Martin, Esq.

Firm: U.S. Patent & Trademark Office

Phone No.: 330-877-0700

Fax No.: 571-273-0025

No. of Pages (including this): 3

Subject: U.S. Patent Application No. 10/047,545

Date: July 8, 2008

Gary Karlin Michelson

Filed: January 16, 2002

THREADED FRUSTO-CONICAL INTERBODY

SPINAL FUSION IMPLANTS

Attorney Docket No. 101.0053-01000

Customer No. 22882

Confirmation No. 4993

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JUL 10 2008

Confirmation Copy to Follow: NO

Message:

CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that the attached Petition To Withdraw From Issue Under 37 C.F.R. § 1.313(a) (\$130 Petition fee is to be charged to Deposit Account No. 50-3726) is being facsimile transmitted to the U.S. Patent and Trademark Office on July 8, 2008.


Sandra L. Blackmon

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PATENT

Attorney Docket No. 101.0053-01000

Customer No. 22882

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Confirmation No.: 4993
Gary Karlin Michelson)	
Serial No: 10/047,545)	Group Art Unit: 3772
Filed: January 16, 2002)	Examiner: Michael A. Brown
For: THREADED FRUSTO-CONICAL)	
INTERBODY SPINAL FUSION)	
IMPLANTS)	

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87/16/2008 CKH/DH/ 00000004 583726 10047545
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01 FC:1464 130.00 DA

Dear Sir:

PETITION TO WITHDRAW FROM ISSUE
UNDER 37 C.F.R. § 1.313(a)

After receipt of a Notice of Allowance dated June 25, 2008, but prior to the payment of the associated issue fee, Applicant requests that the present application be withdrawn from issue. Currently, the parent application, U.S. Serial No. 08/480,908, of the present application is pending, but subject to a "provisional" nonstatutory obviousness-type double patenting ("ODP") rejection based on claims of the present application. Applicant received the ODP rejection in the parent application subsequent to the Notice of Allowance in the present application in an Office Action dated June 27, 2008.¹ According to MPEP § 804 and Chart I-B included therein, an ODP rejection is properly applicable to each of the present and parent applications. Therefore, Applicant requests that the present application be withdrawn from issue, and properly subjected to an ODP rejection.

¹ Note that a previous ODP rejection in the parent application similarly based on claims in the present application was overcome by cancelling the offending claims from the present application. However, after filing two status inquiries on March 20 and June 09, 2008, and waiting six (6) months for prosecution to continue in the parent application, Applicant received yet another ODP rejection based on different claims in the present application.

Additionally, MPEP § 804, page 800-17, indicates that when two applications are each subject to an ODP rejection, "the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer." Thereafter, according to MPEP § 804, page 800-17, "a terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue." Because the parent application was filed June 07, 1995, and the present application was filed January 01, 2002, Applicant submits that the parent application is the earlier filed application by more than six (6) years. Therefore, but for the proper applicability of an ODP rejection to the present application, Applicant submits that both the present and parent applications are in condition for allowance. Accordingly, Applicant requests that the Director facilitate issuance of a Notice of Allowance in the parent application. The parent application has been pending for more than 13 years, and is ripe for issuance of a Notice of Allowance.

The petition fee in the amount of \$130.00 (37 C.F.R. 1.17(h)) is submitted herewith. If there are any additional fees due in connection with the filing of this Petition, please charge the fee to our Deposit Account 50-3726.

Respectfully submitted,

MARTIN & FERRARO LLP

Date: July 8, 2008

By:



Thomas H. Martin

Registration No. 34,383

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